

## REMARKS

### **I. Status of the Claims**

In the Decision on Appeal<sup>1</sup> mailed January 31, 2011 (“Decision”), the Board of Patent Appeals and Interferences (“BPAI”) took the following actions:

- (i) affirmed the rejections of claims 1-4, 6, 8-56 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0021307 to Glenn et al. (“*Glenn*”) in view of U.S. Patent No. 5,948,058 to Kudoh et al. (“*Kudoh*”), and further in view of U.S. Patent No. 6,081,830 to Schindler (“*Schindler*”); and
- (ii) reversed the rejections of claims 5 and 7.

By this Amendment, Applicant amends claims 1, 18, 23, and 26. No prohibited new matter has been added. Exemplary support for the amended features can be found in, for example, page 19, paragraph 3 of the originally-filed specification. Upon entry of the amendments, claims 1-56 will be pending in this application.

Applicant respectfully submit that the pending claims should be allowed over the prior art of record for at least the following reasons.

### **III. Rejection under 35 U.S.C. 103(a)**

Applicant respectfully traverses the rejection of claims 1-4, 6, 8-56 under 35 U.S.C. § 103(a) as being unpatentable over *Glenn* in view of *Kudoh*, and further in view of *Schindler*. A *prima facie* case of obviousness does not exist with respect to the amended claims.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections

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<sup>1</sup> The Decision on Appeal may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Decision on Appeal.

on obviousness cannot be sustained with mere conclusory statements.” *M.P.E.P.* § 2142, 8th Ed., Rev. 7 (July 2008) (internal citation and inner quotation omitted). “[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” *M.P.E.P.* § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P.* § 2141(III).

The asserted combination of *Glenn*, *Kudoh*, and *Schindler* fails to disclose or suggest all of the features of Applicants’ claims. For example, amended independent claim 1 recites a method for transferring electronic data including

upon opening of the e-mail message by the recipient, indicating to the at least one recipient an online state of one or more of the sender and any one other recipient of the e-mail message,

wherein indicating the online state comprises:

determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient, and

determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient.

Applicant submits that *Glenn*, when considered alone or in any proper combination with *Kudoh* and *Schindler*, does not teach or suggest at least the above subject matter of claim 1. Among other things, *Glenn*, *Kudoh*, and *Schindler* do not

teach or suggest “determining an identity of one or more of the sender or any one other recipient by stripping a domain name from an email address associated with the one or more of the sender or any one other recipient” and “determining the online state of the one or more of the sender or any one other recipient by performing a reverse look-up with the determined identity of the one or more of the sender or any one other recipient,” as recited in claim 1. This is at least because there is no disclosure in *Glenn, Kudoh,* and *Schindler* of determining an identity by “stripping a domain name from an email address” associated with one or more of a sender or any one other recipient, and determining an online state by performing a “reverse look-up” based on the determined identity of the one or more of the sender or any one other recipient.

In view of the above differences between the subject matter of independent claim 1 and the cited references, a *prima facie* case of obviousness does not exist with respect to claim 1. Accordingly, the rejection of claim 1 should be withdrawn and the claim should be allowed.

Amended independent claims 18, 23, and 26, though of different scope from claim 1 and each other, recite features similar to those discussed above in connection with claim 1 and should be allowed for similar reasons.

Furthermore, a *prima facie* case of obviousness does not exist with respect to dependent claims 2-17, 19-22, 24-25, and 27-56 at least due to their dependence from one of the allowable independent claims, and further due to the additional features recited by the dependent claims.

In view of the foregoing, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) and the allowance of the pending claims.

**CONCLUSION**

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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